



21 JUN 2007

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| In re Application of | : | |
| TRIFONI, et al. | : | DECISION ON PETITION |
| Serial No.: 10/550,123 | : | |
| PCT No.: PCT/EP04/03424 | : | UNDER 37 CFR 1.47(a) |
| Int. Filing Date: 31 March 2004 | : | |
| Priority Date: 01 April 2003 | : | |
| Atty Docket No.: 267.193 | : | |
| For: METHOD FOR OPERATING A | : | |
| MEMBRANE ELECTROCHEMICAL | : | |
| GENERATOR | : | |

This decision is in response to applicant's "RENEWED RULE 47(a) PETITION" filed 12 April 2007 to accept the application without the signatures of joint inventors, Eduardo Trifoni and Matteo Lenardon. Applicant requests a three month extension of time, which is granted.

BACKGROUND

On 22 March 2006, applicant filed a petition under 37 CFR 1.47(a) to accept the application without the signatures of joint inventors Eduardo Trifoni and Matteo Lenardon. On 04 August 2006, a decision on petition was mailed to applicant indicating that all of the requirements of 37 CFR 1.47(a) were not satisfied.

On 07 September 2006, a renewed petition was filed. On 01 December 2006, a decision dismissing the petition was mailed to applicant indicating that applicant had not yet fulfilled the requirements of 37 CFR 1.47(a).

On 12 April 2007, applicant filed a renewed petition.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR

1.17(g), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Items (1), (3) and (4) above were previously satisfied.

Regarding item (2)¹ above, Petitioner contends that Eduardo Trifoni and Matteo Lenardon have refused to sign the application.

Specifically, with regard to inventor Lenardon, in the 01 December 2006 decision, applicant was advised to present a copy of Anna Tuosto's cover letter (and English translation thereof), to prove as documentary evidence that a complete copy of the application, including claims, drawings, and declaration were mailed to the nonsigning inventor. Applicant was also advised that the letter must identify the application number and identify the enclosures that were sent to Mr. Lenardon. Furthermore, applicant was advised that the cover letter of 21 December 2005 did not identify the application to which it was directed and did not itemize the documents that were enclosed. In addition, the postal receipt (a copy of which was submitted on 22 March 2006) was not translated from the Italian language into the English language and was required.

In her 28 August 2006 declaration, Ms. Tuosto stated that she mailed a complete copy of

¹ Section 409.03(d) of the MPEP, Proof of Unavailability or Refusal, states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

the application, including claims, drawings, declaration and assignment document to Mr. Lenardon. However, the English translation of her letter, provided as documentary evidence that these documents were mailed to the nonsigning inventor, does not support her statement. The letter did not identify the application number and did not identify the enclosures that must be sent to Mr. Lenardon.

As stated above, the cover letter dated 21 December 2005 does not identify the application number to which the letter is directed, but only notes an internal reference number, which the inventor may not be familiar with. This does not apprise the inventor of the application which he is asked to sign. Furthermore, the letter does not detail the contents or enclosures. It is noted that the petition filed on 22 March 2006 indicated that "Anna Tuosto on 21 December 2005 mailed the declaration and assignment to Matteo Lenardon for execution". Ms. Tuosto's letter merely indicates "the document"; this does not make clear "which" document was enclosed and does not seem to confirm that a complete copy of the application was enclosed. This documentary evidence does not support Ms. Tuosto's declaration² that she sent a complete copy of the application to the inventor. Petitioner must provide the nonsigning inventor a complete copy of the application papers before a petition under 37 CFR 1.47(a) can be granted.

Moreover, the English translation of the Italian postal receipt, presented as evidence of the confirmation of receipt by inventor Lenardon, does not appear to be a translation of the proof of confirmation of receipt. Rather, the translation seems to be one of another postal form which deals with acceptance of mail, a statement forbidding enclosing money, blank spaces for the receiver and sender's information, etc. It does not appear to correspond to the Italian postal receipt presented as evidence of the receipt of the materials by the inventor.

Mr. Lenardon's silence cannot be construed as a refusal in the immediate circumstances as it is unclear whether he received the papers and whether the papers did in fact contain a complete copy of the application including an oath or declaration for execution. Ms. Tuosto's letter did not identify the application number and what enclosures were sent to Mr. Lenardon. This letter cannot be relied upon to fulfill the requirements of 37 CFR 1.47(a). Furthermore, since the translation of the postal receipt does not appear to be a translation of the postal receipt at issue, it is unclear that Mr. Lenardon actually received the papers.

With respect to inventor Eduardo Trifoni, a copy of a communication, referred to as an email, sent to him by Ms. Tuosto was provided. However, proof that this message was actually sent and *received by Mr. Trifoni* was not provided. Mr. Trifoni's reply to the email (and English translation thereof) should also be provided to demonstrate the non-signing inventor's refusal to sign the application papers. In cases where it is argued that the non-action of an inventor should be considered a refusal to cooperate it is especially important to provide proof of delivery of the papers, as well as, a firsthand statement of the preparation and mailing of the papers.

² In her August 28, 2006 declaration, submitted with the renewed petition on 7 September 2006, states that "the documents she submitted to the two inventors who refused to execute the above application included a complete application, drawings, claims, declaration and assignment for execution and identified the application by PCT serial no.: PCT/EP04/03424"....

As stated above, where a refusal of the inventor to sign the application papers is alleged, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the papers *for this application* (specification, claims, drawings and oath/declaration) were sent to Eduardo Trifoni and Matteo Lenardon, and *when such papers were sent*. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration. All documentary evidence should be translated into English. See MPEP 409.03(d) for further clarification.

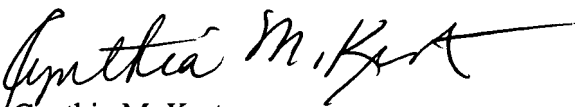
Applicant has not presented sufficient evidence to show that Messrs. Lenardon and Trifoni were presented with and received a complete copy of the application papers including a declaration and that they refuse to sign the application papers. In light of the above, Item (2) above is not yet satisfied and thus, it is inappropriate to grant applicant's petition under 37 CFR 1.47(a) at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED**.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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